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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/571,070	03/08/2006	Hiroshi Sato	040894-7418	2394
9629 7590 10/06/2009 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004				
EXAMINER				
ESTREMSKY, GARY WAYNE				
ART UNIT		PAPER NUMBER		
3677				
MAIL DATE		DELIVERY MODE		
10/06/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/571,070

Applicant(s)

SATO, HIROSHI

Examiner

Gary Estremsky

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-19 is/are pending in the application.
- 4a) Of the above claim(s) 11-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 11-19 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: While the originally presented invention is drawn to staple of class 411, the newly-added claims are drawn to stapler classified in cl 227 and would present a burden undue for the examiner for transfer, search or examination proceeding.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 11-19 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,626,294 to Fujishima in view of JP-A-10-009235 and JP-A-165256 and JP-A-199123.

3. Fujishima '294 teaches Applicant's claim limitations including : a "number of staple members" – 10, a "tearable film" - including 12, "disposed on a side of the staples remote from the center of the roll-like shape" – as shown in Fig 6.
4. Although the reference doesn't explicitly describe details of the tearable film as now claimed, such technique for tearable film is well known to those of ordinary skill in the tearable film art as shown by Japan '235 with hole size as taught by Japan '256 and Japan '123 for example. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the staple roll of Fujishima '294 with film produced as taught by Japan '235 and Japan '256, Japan '123 in order to provide a film that is easy to tear using well known material. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.
5. As regards claim 2, Japan '235, as relied on, discloses hole size and spacing are well known in the art.
6. As regards claims 4,6, inasmuch as the reference, as relied on, describes the structure as claimed, further recitation of the process that produces the claimed structure does not clearly further define any further particular structure of the claimed invention that can be relied on to patentably distinguish from the structure of the prior art. Inasmuch as a *product* claim is defined by its structure, such a claim including a product-by-process limitation is interpreted as including the *structure* formed by the process step (as it would be in a process of making-type claim). In any case, reference discloses manufacture technique that reads on process.

7. Reference illustrates straight shape of staple where it is intended to be bent later as part of its intended use.
8. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-A-10-009235 in view of JP-A-165256 and JP-A-199123 and further in view of 6,626,294 to Fujishima.
9. Japan '235 teaches Applicant's claim limitations including : a "number of staple members" – a plurality of illustrated elements 1, a "tearable film" including 12, "is adhered to a center portion of a staple. Although the reference does not illustrate the film is laminated from porous film as claimed, such technique is well known to one of ordinary skill in the tearable film art as shown by Japan '256 and Japan '123. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the film or Japan '235 using lamination technique as disclosed by Japan '256 and Japan '123 in order to provide a film that is easy to tear using known methods of manufacture.
10. Although reference illustrates film portion 12 rolled closer to the center of the roll, Fujishima '294 discloses that it's well known to roll with film to the outside of roll. One of ordinary skill in the art would recognize that both roll directions are well known in the art as generally equivalent for purpose of rolling whereby choice of either direction would have been an obvious design choice or engineering expedient for one of ordinary skill in the art as an aesthetic choice or to meet other objective of machine etc., not affecting the staples and film specifically.

11. As regards claim 2, Japan '235, as relied on, discloses hole size and spacing are well known in the art.

12. As regards claims 4, 6, inasmuch as reference, as relied on, describes the structure as claimed. In this case, further recitation of the process that produces the claimed structure does not clearly further define any particular structure of the claimed invention that can be relied on to patentably distinguish from the structure of the prior art. Inasmuch as a product claim is defined by its structure, such a claim including a product-by-process limitation is interpreted as including the structure formed by the process, not as a method step (as it would be in a process of making-type claim). In any case, reference discloses manufacture technique that reads on process.

Response to Arguments

Applicant's arguments have been fully considered but are moot in view of the new grounds of rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is 571 272-7055. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached on 571 272-6987. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gary Estremsky

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Art Unit: 3677

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Primary Examiner
Art Unit 3677

/Gary Estremsky/
Primary Examiner, Art Unit 3677